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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,599	08/05/2003	Hartmut Breithaupt	BANH3001/FJD	4820

23364 7590 09/18/2006

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EXAMINER

COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20060907

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Advisory Action and attached letter

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/633,599	Applicant(s) BREITHAUPT, HARTMUT	
	Examiner Charles E. Cooley	Art Unit 1723	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet and attached letter. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: None.
 Claim(s) objected to: None.
 Claim(s) rejected: 10-16, 19, 22, 25, 28 and 31.
 Claim(s) withdrawn from consideration: 1-9, 17, 18, 20, 21, 23, 24, 26, 27, 29, 30, 32 and 33.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached letter.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s).
 13. ☐ Other: _____



Charles E. Cooley
 Primary Examiner
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Continuation of 3. NOTE: The revisions to the claims require further consideration and mandate further review of the prior art .

ADVISORY ACTION - RESPONSE TO ARGUMENTS

Election/Restriction & Election By Original Presentation

1. Newly submitted claims 17, 18, 20, 21, 23, 24, 26, 27, 29, 30, 32, and 33 remain directed to an invention/species that is independent or distinct from the invention originally claimed for the following reasons:

Claims 17, 18, 20, 21, 23, 24, 26, 27, 29, 30, 32, and 33 are drawn to a patentably distinct variants/embodiments of the claimed invention (as clearly established by pages 3-5 of the instant specification) added after a first action on the merits. If such subject matter drawn to these variants/embodiments were presented in the originally filed and elected process claims, the application may have been further subject to an election of species requirement. Furthermore, since all generic claims stand rejected in this final rejection, Applicant is not entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17, 18, 20, 21, 23, 24, 26, 27, 29, 30, 32, and 33 are withdrawn from consideration as being directed to non-elected variants/embodiments. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant asserts that the election requirement made by the examiner was between apparatus and process and Applicant elected the process encompassing claims 10-15 only. However, the specification recites multiple variants/embodiments of

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the apparatus (and apparently of the process as well) that were not claimed when the examiner prepared the first action on the merits for claims 10-15. If the multiple variants/embodiments of the invention were claimed initially, the application may have also been subject to an election of species requirement in addition to the restriction requirement. The "new" claims may indeed be directed to the elected process but they are clearly drawn to different variants/embodiments not treated in the first action on the merits. The examiner determined that new claims 16, 19, 22, 25, 28, and 31 were embraced by the variant of the process originally claimed and the examiner treated those claims on the merits in the final rejection. Claims 17, 18, 20, 21, 23, 24, 26, 27, 29, 30, 32, and 33 drawn to constructively non-elected variants/embodiments were withdrawn from consideration pursuant to MPEP sections 818.01, 818.023(a), 821 and 821.03.

Applicant apparently questions the examiner's authority to withdraw said claims without preparing another election requirement and cites 37 CFR 1.145. However a close reading of this rule states that "the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered". This is exactly what the examiner has done - restricted the claims to the invention previously (originally) claimed in the entered amendment filed after the first action on the merits. This rule states nothing regarding a mandate to prepare a new restriction requirement as Applicant concludes.

Nonetheless, Applicant apparently feels the examiner went far beyond his authority and withdrawing the claims from consideration is a gross injustice. If this

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feeling lingers, the examiner would be remiss in not urging Applicant to promptly petition for relief pursuant to 37 CFR 1.44 since the requirement is still deemed proper and is therefore made FINAL. For further consultation on this matter, the examiner's supervisor Wanda Walker can be reached at 571-272-1151 and the TC director's office can be reached at 571-272-1200.

However, if Applicant can draft allowable generic claims which claims 7, 18, 20, 21, 23, 24, 26, 27, 29, 30, 32, and 33 depend from, the examiner will willingly rejoin the withdrawn claims as depending from an allowable generic claim. However, until allowable generic claims are presented, the claims will remain withdrawn.

Specification

2. The disclosure is objected to because of the following informalities:
 - a. Several words of the specification filed 5 AUG 2003 (apparently a fax copy from E+H PATSERUE WEIL which is the ONLY version in the IFW file) are missing text, perhaps due to a printing error. For example, see page 1 (the title); page 2, last line; page 3, last line; page 5, first and last lines; page 7, first line; page 9, last two lines; page 12, penultimate line. This list is not all-inclusive. Appropriate correction is required.
3. The title of the invention is acceptable.

Claim Rejections - 35 U.S.C. § 102

4. With regard to MOSS, the corresponding steps of the claims are indeed set forth at the paragraph bridging pages 4 and 5 of the final rejection and the operational steps are further discussed at pages 11-15. The particular fluid lines Applicant questions are identified again at the paragraph bridging pages 4 and 5 of the final rejection.

The examiner also notes the phrase "at least intermittently connected" is of such a broad scope to encompass the fluid lines being connected at some times to at all times.

A handwritten signature in black ink, appearing to read "Charles Cooley", with a long horizontal flourish extending to the right.

Charles E. Cooley
Primary Examiner
Art Unit 1723

7 September 2006